

## FROM CUSTOM TO LAW IN COPYRIGHT

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### ABSTRACT

This paper explores two situations where custom may have been misperceived as trumping copyright law. The first part considers why lawyers can copy many practice-related documents without permission and explains why those reasons do not apply to other documents that cannot be so freely copied. The second part considers how schools' customary disinterest in owning copyright in academic employees' works has inappropriately influenced the outcome of unrelated litigation. In both parts, the paper argues that careful attention should be given to reasons for customary behavior before determining its effect on the law.

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**INTRODUCTION**

Custom sometimes seems to trump the law. Professor Robert C. Ellickson's account of an empirical study of cattle-trespass liability begins, "I did not appreciate how unimportant law can be when I embarked on this project."<sup>1</sup> Having examined territory containing both "open" (no need to fence) and "closed" (need to fence) ranges,<sup>2</sup> he found that "people frequently settle disputes in cooperative fashion without paying any attention to the laws that apply . . . ."<sup>3</sup>

Further, he found that livestock owners, some presumably with the financial upper hand as well as a legal right to refuse, nevertheless paid compensation.<sup>4</sup> Such behavior might be expected where, for example, it seems to help preserve long-term relationships or maintain social standing. Yet, that behavior also was seen where such motivation is perceived less easily, as when insurance adjustors also settled without regard for whether disputes arose in open or closed range territory.<sup>5</sup>

Through *stare decisis*, judicial customs become legal norms.<sup>6</sup> Widespread practices may also guide judges, legislators, and others in creating, interpreting or applying the legal norms, but custom cannot replace them.<sup>7</sup> Those

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<sup>1</sup> ROBERT C. ELICKSON, *ORDER WITHOUT LAW: HOW NEIGHBORS SETTLE DISPUTES* vii (1991).

<sup>2</sup> *Id.* at 42–48 (summary of animal trespass law).

<sup>3</sup> *Id.* at vii. According to Ellickson, "[m]ost cattlemen believe that a rancher should keep his animals from eating a neighbor's grass, regardless of whether the range is open or closed." *Id.* at 53.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* at 51.

<sup>6</sup> *See, e.g.*, ANTONIN SCALIA, *A MATTER OF INTERPRETATION: FEDERAL COURTS AND THE LAW* 4 (1997) ("But from an early time . . . any equivalence between custom and common law had ceased to exist, except in the sense that the doctrine of *stare decisis* rendered prior judicial decisions 'custom.'").

<sup>7</sup> *See, e.g.*, Jennifer E. Rothman, *The Questionable Use of Custom in Intellectual Property*, 93 VA. L. REV. 1899, 1946 (2007) (citing "three main justifications for incorporating custom into the law" and maintaining that "none of them justifies the incorporation of custom into IP law."). She hedges, however, noting:

There is . . . a big difference between concluding that custom should not be incorporated wholesale as law or legal rules and concluding that evidence of customary practices should *never* be admissible in IP cases. There are inquiries in IP law, and elsewhere, for which customary practices are relevant and not unduly prejudicial. In such instances it is appropriate, and may be necessary, for courts to consider evidence of customary practices and norms.

who have rights may find it financially or otherwise inexpedient to exercise them despite any need to preserve long-term relationships or maintain social standing.<sup>8</sup> Even between the same parties, estoppel or equivalents aside, however, those who honor legally unenforceable obligations for such reasons do not become thereafter obligated.<sup>9</sup>

That “everyone does it” means only that a practice is acceptable to some group.<sup>10</sup> If persons with conflicting interests are unaware of their rights or have ineffective means to assert them, the situation is apt to change when such hindrances are removed. Even when parties aware of their rights and capable of enforcing them choose not to act, as found by Ellickson,<sup>11</sup> it is useful to reflect on possible reasons and probable boundaries to those reasons.<sup>12</sup>

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*Id.* at 1967 (emphasis added); *see also, e.g.*, *United States v. J.B. Williams Co.*, 498 F.2d 414, 424–25 (2d Cir. 1974) (“[I]f in authorizing a . . . procedure which had always been thought to entail a right of jury trial, Congress had wished to withhold it (assuming arguendo that it could), Congress would have said so in unmistakable terms and not left this as a secret to be discovered many years later.”).

<sup>8</sup> *See* ELLICKSON, *supra* note 1, at 6 n.12 (discussing physical reprisals for flag burning, despite legal rights).

<sup>9</sup> In *Konigsberg International, Inc. v. Rice*, 16 F.3d 355, 356 (9th Cir. 1994), for example, the defendant claimed to have honored an agreement. She was not thereby obligated to do so in the future because the court said the parties “did lunch, not contracts. [And t]hat didn’t satisfy section 204 [of the Copyright Act].” *Id.* at 358. In a different case, but in the same vein:

Cohen[, the appellee.] concedes that “[i]n the best of all possible legal worlds” parties would obey the writing requirement, but contends that moviemakers are too absorbed in developing “joint creative endeavors” to “focus upon the legal niceties of copyright licenses.” Thus, Cohen suggests that we hold section 204’s writing requirement inapplicable here because “it [i]s customary in the motion picture industry . . . not to have written licenses.” To the extent that Cohen’s argument amounts to a plea to exempt moviemakers from the normal operation of section 204 by making implied transfers of copyrights “the rule, not the exception,” we reject his argument.

*Effects Assocs. v. Cohen*, 908 F.2d 555, 556–57 (9th Cir. 1990) (citations omitted).

<sup>10</sup> *See* ELLICKSON, *supra* note 1, at 258–64 (discussing “The Lawlessness of Academic Photocopying”). Ellickson concluded: “Publishers are rightly skittish about initiating welfare-threatening litigation against the employers of the persons on whom many of their book sales depend. As the publishers no doubt recognize, professors, like the residents of rural Shasta County, know how to get even.” *Id.* at 264; *see id.* at 58–59.

<sup>11</sup> *See supra* notes 4–5 and accompanying text.

<sup>12</sup> If infringers are beyond effective reach, owners may pursue those who facilitate infringement. *See Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 924 (2005) (action against party allegedly encouraging infringement of music copyrights); *Princeton Univ. Press v. Mich. Document Servs., Inc.*, 99 F.3d 1381, 1383 (6th Cir. 1996) (action against a copy shop rather than a school or faculty).

In the following two parts, this paper explores relationships where custom may have been misperceived as trumping copyright law. In the first, it considers why lawyers can copy many practice-related documents without permission and explains why those reasons do not apply to other documents that cannot be so freely copied. In the second, it considers how schools' customary disinterest in owning copyright in some works of academic employees has inappropriately influenced the outcome of unrelated litigation. In both parts, the paper argues that careful attention should be given to reasons for customary behavior before determining its effect on the law.

### **I. THE INFLUENCE OF CUSTOM ON PERCEPTIONS OF COPYRIGHT FOR LAWYERS' WORK<sup>13</sup>**

Copyright for many documents generated by lawyers is unlikely to be disputed; for others, it clearly does not exist. In the first category are law reviews, commercial treatises, form books and the like.<sup>14</sup> In the second is "any work of the United States Government," including documents prepared by legal and judicial employees.<sup>15</sup> The second also may contain other documents produced under close government supervision.<sup>16</sup>

The Copyright Act says nothing about works of state or local governments. That rights in these works are rarely asserted, however, tilts strongly against protection for such documents that establish legal rights and obliga-

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<sup>13</sup> Based in part on Thomas G. Field, Jr., *Lawyers Should Be Cautious When Copying Other Lawyers' Work*, IPFRONTLINE, Oct. 31, 2006, <http://www.ipfrontline.com/depts/article.asp?id=13203&deptid=4> (last visited Oct. 14, 2008).

<sup>14</sup> An individual legal form is unlikely to be protected unless it does more than paraphrase preexisting forms. *See, e.g.*, *Donald v. Zack Meyer's T.V. Sales & Serv.*, 426 F.2d 1027, 1030 (5th Cir. 1970). A compilation of forms, however, is more likely to be protected for its selection and organization, if not also for annotations. *See* 17 U.S.C. § 103(b) (2006). Unless otherwise indicated, all subsequent statutory citations are to Title 17 of the U.S. Code—the 1976 Copyright Act [hereinafter the Copyright Act]. The Copyright Act did not become effective until Jan. 1, 1978. Copyright Act, Pub. L. No. 94-553, § 102, 90 Stat. 2541, 2598 (1976).

<sup>15</sup> 17 U.S.C. § 105 (2006). Section 101 defines a "work of the United States Government" as that of any "officer or employee" prepared "as part of that person's . . . duties." 17 U.S.C. § 101 (2006).

<sup>16</sup> *See* *SmithKline Beecham Consumer Healthcare L.P. v. Watson Pharms., Inc.* 211 F.3d 21, 29 (2d Cir. 2000) (refusing copyright for an FDA-approved pharmaceutical label).

tions.<sup>17</sup> Indeed, the Supreme Court of the United States was the first to disclaim copyright in its opinions.<sup>18</sup> It is therefore likely that the Supreme Court would refuse copyright for state court opinions and many, if not all, other documents used in, or generated by, legal proceedings.<sup>19</sup> But absent litigation<sup>20</sup> or statutory guidance, boundaries are undetermined.

For example, copyright for appellate briefs is more defensible than for related court opinions. That these briefs are reproduced commercially, surely with the authors' knowledge and without apparent objection,<sup>21</sup> is weak contrary evidence. Although neither notice<sup>22</sup> nor registration<sup>23</sup> is required, authors of briefs may assume otherwise. Authors as well as publishers may assume, too,

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<sup>17</sup> In that instance, custom is apt to reflect the law. Such evidence is useful to a court, Rothman, *supra* note 7, at 1971, despite protest of "a feedback loop . . . in which custom influences the law, the law reinforces the custom, and the custom then becomes further entrenched." *Id.* at 1946.

<sup>18</sup> See *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 668 (1834) ("[T]he court are unanimously of opinion, that no reporter has or can have any copyright in the written opinions delivered by this court; and that the judges thereof cannot confer on any reporter any such right."); see also *Banks v. Manchester*, 128 U.S. 244, 253 (1888) ("[T]here has always been a judicial *consensus*, [since *Wheaton*,] that no copyright could . . . be secured in the products of the labor done by judicial officers in the discharge of their judicial duties."). See generally Noel Cox, *Copyright in Primary Legal Materials in Common Law Jurisdictions*, 19 AUSTL. I.P.J. 89 (2008) (surveying rights in such documents in several common-law countries, including the United States).

<sup>19</sup> See, e.g., *Veeck v. S. Bldg. Code Cong. Int'l*, 293 F.3d 791, 793 (5th Cir. 2002) (refusing copyright for a privately-authored building code following its adoption by municipalities). *But see Chase v. Pub. Util. Comm'n of Pa.*, No. 1:05-CV-2375, 2008 WL 906491, at \*5–6 (M.D. Pa. Mar. 31, 2008) (finding no conflict between copyright law and the utility commission's ability to honor contracts restricting dissemination of hearing transcripts). Although its pronouncement is of unclear legal or practical effect, see also U.S. Copyright Office, *Compendium of Copyright Office Practices II* § 206.01 (1984), available at [http://ipmall.info/hosted\\_resources/CopyrightCompendium/chapter\\_0200.asp](http://ipmall.info/hosted_resources/CopyrightCompendium/chapter_0200.asp), which states: "Edicts of government, such as judicial opinions, administrative rulings, legislative enactments, public ordinances, and similar official legal documents are not copyrightable for reasons of public policy. This applies to such works whether they are Federal, State, or local as well as to those of foreign governments."

<sup>20</sup> See, e.g., Nate Anderson, *Fight Shaping Up Over Oregon's State Law Copyright Claims*, ARS TECHNICA, May 13, 2008, <http://arstechnica.com/news.ars/post/20080513-fight-shaping-up-over-oregons-state-law-copyright-claims.html> (last visited Oct. 14, 2008).

<sup>21</sup> Michael Whiteman, *Appellate Court Briefs on the Web: Electronic Dynamos or Legal Quagmire?*, 97 LAW LIBR. J. 467, 478–79 (2005) (discussing potential copyright issues regarding legal briefs).

<sup>22</sup> See 17 U.S.C. § 405 (2006) (discussing notice of copyright).

<sup>23</sup> See 17 U.S.C. § 408(a) (2006) (declaring registration as "[p]ermissive"); cf. 17 U.S.C. § 411(a) (2006) (regarding the capacity to sue).

that copyright, which might have existed earlier, is forfeited upon submission. Forfeiture seems to be an open question, but the answer is irrelevant if reproduction constitutes permissible fair use.<sup>24</sup>

To determine whether reproduction is permissible fair use, the four non-exclusive factors set out in § 107 of the Copyright Act are analyzed.<sup>25</sup> Of the first factor, concerning “the purpose and character of the use,”<sup>26</sup> the Supreme Court once said, “every commercial use of copyrighted material is presumptively an unfair exploitation,”<sup>27</sup> but it later held that “[i]n giving virtually dispositive weight to the commercial nature of the parody, the Court of Appeals erred.”<sup>28</sup> The central concern instead is “whether the new work merely ‘supersede[s] the objects’ of the original”<sup>29</sup>—something that, though seemingly central to all four factors, is doubtful when briefs are copied.

The second factor, which concerns “the nature of the copyrighted work,”<sup>30</sup> is said to “call[] for recognition that some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied.”<sup>31</sup> Yet, because briefs, unlike many works, are authored without regard to potential royalty income, that factor would appear to favor fair use.

The third factor, regarding “the amount and substantiality of the portion used,”<sup>32</sup> poses the most difficulty for those who reproduce entire briefs. But the fourth factor, concerning the “effect . . . upon the potential market . . . of the copyrighted work,”<sup>33</sup> combined with the first two factors, suggests that copying would be fair. It is difficult to see how reproduction would diminish possible markets for existing briefs, much less reduce incentives to write more. Indeed, increased exposure through publication would seem to improve opportunities for further work.

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<sup>24</sup> See 17 U.S.C. § 107 (2006) (precluding copyright infringement if fair use); see also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 576 (1994) (characterizing § 107 as a codification of “judge-made doctrine.”). Indeed, *Campbell* attends as much to *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4,901), as to the Copyright Act.

<sup>25</sup> § 107.

<sup>26</sup> § 107(1).

<sup>27</sup> *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984) (dicta).

<sup>28</sup> *Campbell*, 510 U.S. at 584.

<sup>29</sup> *Id.* at 579 (quoting *Folsom*, 9 F. Cas. at 348).

<sup>30</sup> § 107(2).

<sup>31</sup> *Campbell*, 510 U.S. at 586.

<sup>32</sup> § 107(3).

<sup>33</sup> § 107(4).

No attorney alert to the last point is likely to oppose publication of entire briefs with related cases, but another lawyer's use of only a portion of a brief may be seen in a very different light. Although such use is unlikely, for example, to "supersede[] the objects of the original"<sup>34</sup> or to adversely affect incentives to write more briefs, reproduction without attribution might be seen to divert future work. Judges who view such practices as unfair<sup>35</sup> will be tempted to find not only that copyright arises when such works are fixed,<sup>36</sup> but also that copyright is not forfeited upon voluntary inclusion in the public record.<sup>37</sup>

Documented protests against free riding on lawyer's work are scarce.<sup>38</sup> Incidents that occurred in 2002 are, however, illuminating. William Lerach, of Milberg Weiss Bershad Hynes & Lerach (Milberg Weiss),<sup>39</sup> is reported to have complained: "It's been a longstanding practice of certain law firms simply to take our work product, actually our clients' work product, and then copy it and use it for their own benefits."<sup>40</sup>

That practice prompted Lerach's firm to obtain copyright registrations<sup>41</sup>—unnecessary for copyright, but necessary for suit.<sup>42</sup> Although registration of unpublished work prior to infringement offers important remedial advan-

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<sup>34</sup> *Campbell*, 510 U.S. at 579 (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841)) (internal quotations omitted).

<sup>35</sup> *E.g.*, *Marcus v. Rowley*, 695 F.2d 1171, 1175–76 (9th Cir. 1983) (using failure to attribute as a factor in finding no fair use).

<sup>36</sup> *See* 17 U.S.C. § 102(a) (2006).

<sup>37</sup> *See Veeck v. S. Bldg. Code Cong. Int'l*, 293 F.3d 791, 797 (5th Cir. 2002); *SmithKline Beecham Consumer Healthcare v. Watson Pharms.*, 211 F.3d 21, 29 (2d Cir. 2000).

<sup>38</sup> *See* Davida H. Isaacs, *The Highest Form of Flattery? Application of the Fair Use Defense Against Copyright Claims for Unauthorized Appropriation of Litigation Documents*, 71 MO. L. REV. 391, 393 (2006) (citing a "centuries-old tradition" of lawyers not protesting use of their work by "fellow members of the Bar."). Form books containing, for example, model complaints intended for use in legal proceedings are, of course, published for that purpose. The validity of copyright in such books is unlikely to be doubted, and use under other than an implied license would not be tolerated.

<sup>39</sup> Lerach has been described as "one of the best-known plaintiffs' securities class action lawyers in the country." Janet L. Conley, *Milberg Weiss Tries to Nail Class Action Imitators*, FULTON COUNTY DAILY REP., Nov. 20, 2002, <http://www.law.com/jsp/article.jsp?id=1036630458145> (last visited Oct. 14, 2008). Ms. Conley's account is both interesting and detailed.

<sup>40</sup> *Id.*

<sup>41</sup> *Id.*

<sup>42</sup> 17 U.S.C. § 411(a) (2006); *see also* 17 U.S.C. § 410(c) (2006) (presumption of validity).

tages,<sup>43</sup> belated registration nevertheless allows recovery of actual damages and profits<sup>44</sup> as well as injunctions to halt future infringement.<sup>45</sup>

Actual damages and profits are usually generated directly by impermissible copying.<sup>46</sup> Conley's article reporting on Lerach's grievance, however, offers this hypothetical: "A copycat law firm settles the suit for \$400,000; Milberg Weiss alleges it could have settled for \$1 million and sues the copycat firm for its share of lost fees—say, 40 percent of the \$600,000 difference."<sup>47</sup> Yet that measure of harm incorporates damages that seem both remote and difficult to prove.<sup>48</sup>

One case, discussed below, did permit recovery of sums only remotely related to copying, but the measure of recovery seems not to have been contested.<sup>49</sup> As for the Milberg Weiss disputes, they apparently were resolved without litigation, perhaps to avoid spending considerable sums to resolve the measure of damages and a host of other difficult issues.<sup>50</sup>

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<sup>43</sup> See 17 U.S.C. § 412 (2006) (permitting recovery of statutory damages up to \$150,000 under § 504(c) and attorney fees under § 505).

<sup>44</sup> 17 U.S.C. § 504(a) (2006).

<sup>45</sup> 17 U.S.C. § 502 (2006).

<sup>46</sup> See 17 U.S.C. §§ 106(1)–(2) (2006) (discussing reproduction and derivative works).

<sup>47</sup> Conley, *supra* note 39.

<sup>48</sup> For this and other reasons, as I mentioned to Janet Conley, copyright may not be the only, or even the best, option in such circumstances. Conley, *supra* note 39. For example, in *National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997), misappropriation was held actionable if:

(i) [A] plaintiff generates or gathers information at a cost; (ii) the information is time-sensitive; (iii) a defendant's use of the information constitutes free riding on the plaintiff's efforts; (iv) the defendant is in direct competition with a product or service offered by the plaintiffs; and (v) the ability of other parties to free-ride on the efforts of the plaintiff or others would so reduce the incentive to produce the product or service that its existence or quality would be substantially threatened.

*Id.* at 845. In that context, I said only that facts are not copyrightable, but my comment was reported in Isaacs, *supra* note 38, at 394 n.14, as reflecting disagreement with MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 2.18[E] (2000), stating: "There appear to be no valid grounds why legal forms such as contracts, insurance policies, pleadings and other legal documents should not be protected under the law of copyright." I heartily agree with that statement.

<sup>49</sup> *Pham v. Jones*, No. Civ.A. H-05-2027, 2006 WL 1342826, at \*6–7 (S.D. Tex. May 13, 2006).

<sup>50</sup> See Isaacs, *supra* note 38, at 393 (flagging the dearth of litigation and the resulting difficulty of unresolved issues); see also Stanley F. Birch, Jr., *Copyright Protection for Attorney Work Product: Practical and Ethical Considerations*, 10 J. INTEL. PROP. L. 255, 256, 262 (2003)

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In any event, lack of reported litigation and sparse commentary may blind lawyers<sup>51</sup> to the potential utility of promptly<sup>52</sup> registering<sup>53</sup> documents of more than ephemeral value. Conversely, lack of reported litigation and sparse commentary may induce unwarranted assumptions that lawyers' work can be copied.

Consider *Pham v. Jones*,<sup>54</sup> for example. Had Pham been aware of the advantages, he probably would have promptly registered a form letter and brochure used to solicit prospective clients.<sup>55</sup> Conversely, lack of litigation and commentary may have led Jones to believe that it was proper to use another lawyer's work to the same end.<sup>56</sup>

As recounted in the opinion, Pham had, since 2001, contacted persons identified by arrest records, using his materials to inform them of "their rights and options as well as of the legal services he provide[d]."<sup>57</sup> In 2005, after noticing a 25% decline in business, Pham discovered that Jones, a new lawyer, was using "virtually mirrored" copies of Pham's materials to the same end.<sup>58</sup> When Jones continued despite protest, Pham registered copyright and filed suit.<sup>59</sup> Pham ultimately received \$54,124.87, representing profits, attorney fees and costs.<sup>60</sup> Jones also was permanently enjoined from using Pham's materials and warned that any violation would be punishable by contempt of court.<sup>61</sup>

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(relating how one law firm lifted "hundreds of pages of land restrictions and covenants" from another, and that a protest resulted in compensation).

<sup>51</sup> Indeed, Conley reported that Milberg Weiss did not take action until someone took Lerach "aside and said, 'You're being taken advantage of. You shouldn't tolerate it. You should copyright your complaints.'" Conley, *supra* note 39.

<sup>52</sup> See *supra* note 43 and accompanying text.

<sup>53</sup> The \$45 basic registration fee (\$35 for online registration) and a straight-forward process are set out by the Copyright Office at <http://www.copyright.gov/register/literary.html>.

<sup>54</sup> No. Civ.A. H-05-2027, 2006 WL 1342826 (S.D. Tex. May 13, 2006).

<sup>55</sup> *Id.* at \*1. Nothing indicates that Pham applied before infringement. Apparently to make jurisdiction under § 411 clear, the opinion relates only that certificates of registration issued in 2005. *Id.*

<sup>56</sup> Despite Pham's protest, Jones apparently did not stop until issuance of a preliminary injunction. *Id.*

<sup>57</sup> *Id.*

<sup>58</sup> *Id.* at \*2.

<sup>59</sup> *Id.* at \*1.

<sup>60</sup> *Id.* at \*5-7.

<sup>61</sup> *Id.* at \*7.

Jones, who was defending pro se, appears to have been unaware that Pham was not entitled to attorney fees for failure to register promptly.<sup>62</sup> Those fees (\$29,100) represented over half of Pham's recovery.<sup>63</sup> Without them, the injunction would have *cost* Pham \$4075.13 more than he recovered<sup>64</sup>—a sum presumably worth spending, but suit would have been less advantageous.

As the opinion notes, "Pham did not offer evidence as to the actual damages he suffered, but instead focused on Jones's profits from the use of the copyrighted letter and brochure."<sup>65</sup> The computation of profits seems particularly interesting: "[T]he Court finds Pham established by a preponderance of the evidence that Jones's gross revenues were \$33,900.00 during the infringement period. . . . Thus, the burden shifts to Jones to prove deductible expenses and any profits attributable to factors other than the copyrighted work."<sup>66</sup>

The opinion credits only \$9445.13 (the cost for Jones to print and mail his own materials) as deductible expenses.<sup>67</sup> Lacking documentation to show the portion of income "attributable to factors other than the copyrighted letter and brochure, such as word-of-mouth advertising," \$24,454.87 was found to be recoverable profit.<sup>68</sup> It is not surprising that Jones received no credit for unproven expenses.<sup>69</sup> It may seem noteworthy that profits were measured in terms of profits only indirectly related to impermissible reproduction and distribution of copyrighted materials used for solicitation, but that is not unique.<sup>70</sup>

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<sup>62</sup> See *supra* text accompanying note 55. Yet, § 412 states that neither attorney fees nor statutory damages may be recovered unless the infringed work was registered prior to infringement, if unpublished, or within three months of publication. 17 U.S.C. § 412 (2006).

<sup>63</sup> *Pham*, 2006 WL 1342826, at \*6–7. The court ordered Jones to pay a total of \$54,124.87. *Id.* at \*7.

<sup>64</sup> *Id.* (potentially awarding only \$54,124.87 - \$29,100 = \$25,024.87).

<sup>65</sup> *Id.* at \*4.

<sup>66</sup> *Id.* at \*4–5 (citing § 504(b)).

<sup>67</sup> *Id.* at \*5.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.* (finding only proof of the cost of printing and mailing as deductible expenses). Section 504(b) allows recovery of "actual damages suffered . . . as a result of . . . infringement, and any profits . . . attributable to . . . infringement . . ." 17 U.S.C. § 504(b) (2006). With regard to the latter, "the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove . . . elements of profit attributable to factors other than the copyrighted work." § 504(b).

<sup>70</sup> See *Andreas v. Volkswagen of Am., Inc.*, 336 F.3d 789, 797–98 (8th Cir. 2003) (affirming jury award of profits based on infringement in advertising); *Mackie v. Rieser*, 296 F.3d 909, 915–16 (9th Cir. 2002) (specifying indirect profits from infringement in advertising can be recovered if plaintiff proves causal link, but the correlation is found too speculative).

Attorneys may have traditionally been less inclined to protest copying than to share documents with colleagues.<sup>71</sup> If so, this may have been motivated, for example, by a desire to preserve professional standing. Yet, when sharing is unlikely to be mutual, lawyers increasingly familiar with intellectual property law may be more apt to perfect and enforce their rights.<sup>72</sup> At least with regard to documents outside public records, as in *Pham*, they are likely to prevail. Lawyers who rely on overbroad notions of custom are sure to suffer accordingly.

## II. COPYRIGHT CUSTOMS IN ACADEMIA: MYTHS AND REALITIES<sup>73</sup>

Section 201(a) provides that copyright vests initially in authors and § 204 requires transfers of ownership to be written and signed by owners or agents.<sup>74</sup> Section 201(b), however, provides that “[i]n the case of a work made for hire,” employers are regarded as authors unless “the parties have expressly agreed otherwise in a written instrument signed by *them*.”<sup>75</sup> Section 101 defines the phrase “work[s] made for hire” to include works “prepared by an employee within the scope of his or her employment.”<sup>76</sup> At a minimum, “employee,”

<sup>71</sup> When I was interviewed by Conley, *see* Conley, *supra* note 39, skepticism reflected there and in Isaacs, *supra* note 38, at 394, n. 14, was animated in part by this perception.

<sup>72</sup> Some may also seek patents. *See, e.g.*, Steve Seidenberg, *Crisis Pending*, 93 A.B.A. J. 42, 42 (2007) (patenting strategies), *available at* [http://www.abajournal.com/magazine/crisis\\_pending](http://www.abajournal.com/magazine/crisis_pending).

<sup>73</sup> Based, in part, on my comment in Thomas G. Field, Jr., *Is the Work-for-Hire Doctrine Trumped by Custom?*, IPFRONTLINE, June 14, 2007, <http://www.ipfrontline.com/depts/article.asp?id=15376&deptid=4> (last visited Oct. 14, 2008).

<sup>74</sup> 17 U.S.C. §§ 201(a), 204(a) (2006).

<sup>75</sup> § 201(b) (emphasis added). With regard to the specific phrase, “work made for hire,” the Court said, in *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 n.3 (1989) (CCNV): “We use the phrase ‘work for hire’ interchangeably with the more cumbersome statutory phrase ‘work made for hire.’” In this paper, the former phrase is used exclusively.

The primary concern thus far addressed in litigation has been ownership, but whether a work is for hire has other implications, such as the duration of the copyright. Under § 302(a), copyright lasts for the lifetime of the author, plus seventy years; under § 302(b), the term for joint works is seventy years beyond the death of the last surviving author; under § 302(c), however, copyright lasts 120 years from creation or ninety-five years from publication, “whichever expires first.” *See* 17 U.S.C. § 302 (2006). Of potentially greater significance, transfers of works not for hire may be terminated after as few as thirty-five years. *See* 17 U.S.C. §§ 203(a)(3), 304(c)(3) (2006).

<sup>76</sup> 17 U.S.C. § 101 (2006).

which is not defined in the Copyright Act, includes “formal, salaried employees.”<sup>77</sup>

The justification for requiring employees as well as employers to sign a document before employees can be regarded as authors is difficult to understand, and, as mentioned in *Hays v. Sony Corp. of America*,<sup>78</sup> no justification is found in the legislative history.<sup>79</sup>

Although *Hays* concerned high school teachers whose work was found not for hire, the opinion gives considerable attention to college faculty:<sup>80</sup>

Until 1976, the statutory term “work made for hire” was not defined, and some courts had adopted a “teacher exception” whereby academic writing was presumed not to be work made for hire. The authority for this conclusion was in fact scanty, . . . but it was scanty not because the merit of the exception was doubted, but because, on the contrary, virtually no one questioned that the academic author was entitled to copyright his writings. . . . [T]he universal assumption and practice was that (in the absence of an explicit agreement . . .) the right to copyright such writing belonged to the teacher rather than to the college or university. There were good reasons for the assumption. A college or university does not supervise its faculty in the preparation of academic books and articles, and is poorly equipped to exploit their writings, whether through publication or otherwise . . . .

The reasons for a presumption against finding academic writings to be work made for hire are as forceful today as they ever were. . . . [C]onsidering the havoc that such a conclusion would wreak in the settled practices of academic institutions, the lack of fit between the policy of the work-for-hire doctrine and the conditions of academic production, and the absence of any indication that Congress meant to abolish the teacher exception, we might, if forced to decide the issue, conclude that the exception had survived the enactment of the 1976 Act.<sup>81</sup>

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<sup>77</sup> See *CCNV*, 490 U.S. at 739–40 (listing that and several other options).

<sup>78</sup> 847 F.2d 412 (7th Cir. 1988), *abrogated on other grounds by* *Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384 (1990).

<sup>79</sup> *Id.* at 416.

<sup>80</sup> *Id.* at 417 (“Unlike college and university teachers, high-school teachers normally are not expected to do writing as part of their employment duties.”).

<sup>81</sup> *Id.* at 416–17 (citations omitted). Two articles, Todd Simon, *Faculty Writings: Are They “Works Made For Hire” Under the 1976 Copyright Act?*, 9 J.C. & U.L. 485 (1983) and Rochelle Cooper Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590 (1987), both arguing to the contrary, were cited by the court. *Id.* at 416. Such views, however, were dismissed as “literalist.” *Id.* But see Leonard D. DuBoff, *An Academic’s Copyright: Publish and Perish*, 32 J. COPYRIGHT SOC’Y 17, 33–34 (1984) (also arguing that the teacher exception was abolished in the Copyright Act). As mentioned by Judge Posner, that authority is scanty is worthy of consideration, *Hays*, 847 F.2d at 416–17, but it seems to prove nothing standing alone.

*Williams v. Weisser*,<sup>82</sup> one of the earliest cases to address the issue, involved the reproduction of notes taken during a UCLA professor's lecture.<sup>83</sup> The defendant paid students to attend the lectures and take notes, which he subsequently sold with copyright notice in his name.<sup>84</sup> Custom was seen as a factor supporting compensatory and exemplary damage awards, as well as an injunction to halt Weisser's publication and sale of the lecture notes.<sup>85</sup> Custom was, however, only one of several factors important to the resolution of that dispute.

After "[f]riction arose between defendant and the administration," a memorandum from administrators at UCLA, based on consultation with university counsel, concluded that "the common law copyright in a lecture is the property of the lecturer rather than of the University, and therefore any legal actions for the infringement of such right must be brought in the name of the aggrieved faculty member."<sup>86</sup> Moreover, Vice Chancellor Sherwood, one author of that memorandum, testified for the plaintiff.<sup>87</sup> Besides explaining the memorandum, he also related that the University of California Press treated university professors the same as other authors.<sup>88</sup> "This was, to his knowledge, the practice throughout the United States."<sup>89</sup>

To rebut such evidence of Williams's ownership, Weisser first claimed that, under the California Labor Code, Williams owned nothing "except the

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<sup>82</sup> 273 Cal. App. 2d 726 (Cal. Ct. App. 1969).

<sup>83</sup> *Id.* at 729.

<sup>84</sup> *Id.*

<sup>85</sup> *Id.* at 729, 734–35, 744. Copyright is the focus, but defendant also lost on privacy grounds. *Id.* at 741–42.

<sup>86</sup> *Id.* at 731. In that regard, failure of other UCLA faculty members to enforce their rights, some actually "cooperat[ing] with defendant in revising the product of the note takers," did not adversely affect Williams's copyright claim. *Id.* at 742. Rather, it supported his privacy claim because "[a]ny person aware of the cooperation given by other faculty members could reasonably believe that plaintiff had assisted in the final product." *Id.*

<sup>87</sup> *Id.* at 731.

<sup>88</sup> *Id.* at 731–32.

<sup>89</sup> *Id.* at 732. That pattern apparently continues. See, e.g., *Princeton Univ. Press v. Mich. Document Servs., Inc.*, 99 F.3d 1381, 1384 (6th Cir. 1996) (alleging copyright infringement against copy-shop for reproduction of professors' work owned by Princeton). Six works were at issue in *Princeton University Press*, one of which was written by Nancy J. Weiss, *id.*, then a history professor at Princeton University. See, e.g., Nancy J. Weiss, Book Review, 92 AM. J. OF EDUC. 352, 352, available at <http://www.jstor.org/pss/1085014>. Princeton, rather than Weiss, however, may have assigned the copyright.

compensation which is due to him from his employer.”<sup>90</sup> The court, however, found the provision upon which he relied to be inapplicable.<sup>91</sup>

Weisser also claimed that UCLA owned the copyright in Williams’s notes because they were works for hire.<sup>92</sup> Regarding that, the court said:

[N]either the record in this case nor any custom known to us suggests that the university can prescribe his way of expressing the ideas he puts before his students. Yet expression is what this lawsuit is all about. No reason has been suggested why a university would want to retain the ownership in a professor’s expression. . . .

Indeed the undesirable consequences which would follow from a holding that a university owns the copyright to the lectures of its professors are such as to compel a holding that it does not. Professors are a peripatetic lot, moving from campus to campus. The courses they teach begin to take shape at one institution and are developed and embellished at another. That, as a matter of fact, was the case here. Plaintiff testified that the notes on which his lectures were based were derived from a similar course which he had given at another university. If defendant is correct, there must be some rights of that school which were infringed at UCLA. Further, should plaintiff leave UCLA and give a substantially similar course at his next post, UCLA would be able to enjoin him from using the material which, according to defendant, it owns.

No one but defendant, an outsider as far as the relationship between plaintiff and UCLA is concerned, suggests that such a state of the law is desirable.<sup>93</sup>

The court went on to discuss in detail “a short but sturdy line of authorities . . . none . . . [with] the teacher opposed by the institution . . . .”<sup>94</sup> Although defendants in those cases apparently could have done so, “that none . . .—pirates all—ever thought that the question of the institution’s rights, as such, was worth raising is surely not without significance.”<sup>95</sup>

This case is said to support the idea that professors’ *writings* should not be regarded as works for hire,<sup>96</sup> but nothing *written* by Williams was copied.<sup>97</sup>

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<sup>90</sup> *Williams*, 273 Cal. App. 2d at 733.

<sup>91</sup> *Id.* at 733–34.

<sup>92</sup> *Id.* at 734.

<sup>93</sup> *Id.* at 734–35.

<sup>94</sup> *Id.* at 736.

<sup>95</sup> *Id.*

<sup>96</sup> See Laura G. Lape, *Ownership of Copyrightable Works of University Professors: The Interplay Between the Copyright Act and University Copyright Policies*, 37 VILL. L. REV. 223, 242–43 (1992).

<sup>97</sup> *Williams*, 273 Cal. App. 2d at 734.

The first relevant writing occurred when Weisser's agent surreptitiously took notes despite protest.<sup>98</sup>

Although the 1909 Act did not apply because there had been no "divestive publication,"<sup>99</sup> Weisser also urged application of the work-for-hire doctrine developed under that Act.<sup>100</sup> That, too, was rejected because "the undesirable consequences which would follow from a holding that a university owns the copyright to the lectures of its professors are such as to compel a holding that it does not."<sup>101</sup>

Thus, the court concluded, "no authority supports the argument that the copyright to plaintiff's notes is in the university. The indications from the authorities are the other way and so is common sense."<sup>102</sup> That conclusion, however, must be read in light of concern about faculty mobility<sup>103</sup> and lack of sympathy for an undeserving third party.<sup>104</sup>

What seemed like "common sense" to the *Williams* court<sup>105</sup> may appear otherwise when, as in *Vanderhurst v. Colorado Mountain College District*,<sup>106</sup> a school, instead of a third party, claims institutional ownership of written materials.

It is undisputed that Vanderhurst prepared the Outline on his own time with his own materials. However, there is no genuine dispute that Vanderhurst's creation of the Outline was connected directly with the work for which was [sic] employed to do and was fairly and reasonably incidental to his employment. . . . I conclude, therefore, that pursuant to the "work for hire" doctrine,

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<sup>98</sup> Indeed, unauthorized attendance of Williams's classes was found to support an award of exemplary damages. *Id.* at 743–44. Moreover, had there been any reason to raise the issue, it is doubtful that the common law rules of California would differ from that provided by the definition of "fixed" in § 101 of the Copyright Act. To be recognized legally, fixation must be "by or under the authority of the author." 17 U.S.C. § 101 (2006).

<sup>99</sup> *Williams*, 273 Cal. App. 2d at 740–41.

<sup>100</sup> *Id.* at 734.

<sup>101</sup> *Id.*

<sup>102</sup> *Id.* at 740. The significance of the reference to his notes is unclear. Nothing indicates that his lectures were verbatim recitations.

<sup>103</sup> *See id.* at 734 ("Professors are a peripatetic lot, moving from campus to campus. The courses they teach begin to take shape at one institution and are developed and embellished at another."). The court was also skeptical that UCLA's ownership of Williams's lectures would prevent him from going elsewhere unless he took up new subjects. *Id.* at 732 n.4.

<sup>104</sup> *See id.* at 735 (referring to defendant as an "outsider as far as the relationship between plaintiff and UCLA is concerned.").

<sup>105</sup> *Id.* at 740–41.

<sup>106</sup> 16 F. Supp. 2d 1297 (D. Colo. 1998).

as of 1995, any copyright remaining in the Outline did not belong to Vanderhurst.<sup>107</sup>

Likewise, in *Forasté v. Brown University*,<sup>108</sup> plaintiff's work was clearly for hire, but, in contrast to *Vanderhurst*, a claim to copyright ownership was based on a written policy providing: "[A]s a general premise, ownership of copyrightable property which results from performance of one's University duties and activities will belong to the author or originator. This applies to books, art works, software, etc."<sup>109</sup>

Disputed copyrights covered "thousands of photographs whose subjects spanned a panoramic range—from portrayals of academic life at Brown University to renderings of the campus' natural beauty."<sup>110</sup> How Forasté, a staff photographer whose employment "came to an end as a result of a staff cutback,"<sup>111</sup> planned to use his work does not appear, but it seems unsurprising that Brown University wanted more than the "right to use such materials for its own educational and research purposes."<sup>112</sup>

Brown University probably did not intend its staff to own copyright in materials prepared only for institutional use. If its intentions were unclear, however, that was inconsequential. The court found the text of § 201(b) "unambiguously"<sup>113</sup> to require that documents vesting or transferring copyright ownership in works for hire to employees be signed by both of "them."<sup>114</sup>

Disputes over ownership of copyright in academic works are uncommon, but cases such as *Vanderhurst* and *Forasté* are especially rare. More typically, as in *Williams* and cases where ownership is not the central concern,

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<sup>107</sup> *Id.* at 1307 (applying 17 U.S.C. § 201(b)). To support the quoted conclusion that the work was for hire, despite being done "on his own time with his own materials," the court cited the § 101 definition and *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989) (CCNV). *Id.*

<sup>108</sup> 248 F. Supp. 2d 71 (D.R.I. 2003).

<sup>109</sup> *Id.* at 74. Such policies are common and several are available online. American Distance Education Consortium, University Intellectual Property Policies, <http://www.adec.edu/user/ip-policies.html> (last visited Oct. 5, 2008); see also Lape, *supra* note 96, at 224, 251–68 (analyzing "the copyright policies at seventy leading research universities in effect" prior to *Forasté*).

<sup>110</sup> *Forasté*, 248 F. Supp. 2d at 73.

<sup>111</sup> *Id.* at 74.

<sup>112</sup> *Id.*

<sup>113</sup> *Id.* at 81.

<sup>114</sup> See text accompanying *supra* note 75. As Professor Jessica Litman kindly mentioned in a private email, that requirement would seem to be satisfied, however, when copyright policies are part of collective bargaining agreements signed by both employers' and employees' agents.

schools are bystanders or have no reason to assert ownership. The first is true of *Hays*, mentioned above,<sup>115</sup> and the second is true of *Weinstein v. University of Illinois*,<sup>116</sup> an earlier Seventh Circuit case.

Indeed, in *Weinstein*, the university would have had every reason to reject ownership of copyright or anything else concerning a published journal article when a discharged faculty member<sup>117</sup> appears to have relied in part on institutional ownership to sue the school.<sup>118</sup> The court, however, refused to find that § 201(b) “make[s] every academic article a ‘work for hire’ and therefore vest[s] exclusive control in universities rather than scholars.”<sup>119</sup> Instead, it found, based on an “academic tradition since copyright law began,”<sup>120</sup> that the work was not for hire and that the university’s written policy did not trump the presumption thereby created.<sup>121</sup>

Yet, plaintiff’s sole grievance, that he was not the first-listed author on the published article at the center of the dispute, seems to have nothing to do with ownership because the copyright was held by the journal in which it appeared.<sup>122</sup> The court showed little sympathy: “Weinstein is litigating a defunct claim. He hasn’t a chance; he never did; but he has put the University to some expense. This is frivolous litigation.”<sup>123</sup> Despite Judge Cudahy’s dissent,<sup>124</sup> the majority awarded attorney fees to the university even though it failed to seek them.<sup>125</sup>

Of perhaps more significance to the issue of concern here, Judge Cudahy appeared only reluctantly to concur with the majority’s assumption that a

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<sup>115</sup> *Hays v. Sony Corp. of Am.*, 847 F.2d 412 (7th Cir. 1988), *abrogated on other grounds by Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384 (1990); *see supra* notes 78–81 and accompanying text.

<sup>116</sup> 811 F.2d 1091 (7th Cir. 1987).

<sup>117</sup> *Id.* at 1096–97.

<sup>118</sup> *Id.* at 1093 (“The district court concluded that the article was the University’s property rather than Weinstein’s property because it was a ‘work for hire.’”).

<sup>119</sup> *Id.* at 1094 (citing DuBoff, *supra* note 81).

<sup>120</sup> *Id.*

<sup>121</sup> *Id.*

<sup>122</sup> *Id.* at 1092. The court *assumed* that this would constitute an injury-in-fact, *id.* at 1093, despite references to journal ownership of the copyright. *Id.* at 1094–95. That practice may change. *See* Thomas G. Field, Jr., *Publishers’ Rights and Wrongs in the Cyberspace*, 39 *IDEA* 429, 429 (1999). The heart of traditional practices is nevertheless seen to be worth keeping. *Id.* at 430–31.

<sup>123</sup> *Weinstein*, 811 F.2d at 1098.

<sup>124</sup> *Id.* at 1098–99 (Cudahy, J., concurring in part and dissenting in part).

<sup>125</sup> *Id.* at 1098 (majority opinion).

property interest was involved: “With respect to the literary property claim, I am less inclined than the majority to concede the existence of state action. . . . The involvement of the state in this private dispute can be described as peripheral at best.”<sup>126</sup> Because those points seem well taken, one must wonder why the court would use such an opportunity to cast doubt on the applicability of § 201(b) in academic settings.

More recently, *Bosch v. Ball-Kell*<sup>127</sup> applied that holding<sup>128</sup> as well as previously quoted dicta from *Hays*;<sup>129</sup> the logic of the latter said to be “compelling.”<sup>130</sup> As in those cases, however, no school claimed ownership of copyright. Rather, *Bosch* was suing colleagues for intentional infliction of emotional distress as well as for direct and vicarious copyright infringement.<sup>131</sup>

*Bosch*’s copyright claims were supported not only by written school policy but also by the findings of a Senate Committee on Academic Freedom and Tenure to whom she had also complained.<sup>132</sup> That Senate Committee’s findings were based in part on opinions from the university’s intellectual property office as well as from its associate counsel.<sup>133</sup> All institutional actors regarded defendants to have stolen and counterfeited work that *Bosch* owned.<sup>134</sup> On those facts, the court refused defendant’s related motion for summary judgment.<sup>135</sup>

When, despite apparent failure to do so earlier, *Bosch* could have easily satisfied the letter as well as the spirit of § 201(b), it may seem surprising that the defendants based their defense on institutional ownership.<sup>136</sup> Whether infringement was continuing is unclear, but the key events had occurred in 2002—about three years before the date of the opinion.<sup>137</sup> Thus, the most plausible

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<sup>126</sup> *Id.* at 1099 (Cudahy, J., concurring in part and dissenting in part).

<sup>127</sup> No. 03-1408, 2006 WL 2548053 (C.D. Ill. Aug. 31, 2006).

<sup>128</sup> *Id.* at \*8.

<sup>129</sup> *Hays v. Sony Corp. of Am.*, 847 F.2d 412 (7th Cir. 1988), *abrogated on other grounds by Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384 (1990); *see also supra* notes 78–81 and accompanying text.

<sup>130</sup> *Bosch*, 2006 WL 2548053, at \*7.

<sup>131</sup> *Id.* at \*3.

<sup>132</sup> *Id.* at \*7.

<sup>133</sup> *Id.* at \*8.

<sup>134</sup> *Id.* at \*7–8.

<sup>135</sup> *Id.* at \*8.

<sup>136</sup> *See Williams v. Weisser*, 273 Cal. App. 2d 726, 736 (Cal. Ct. App. 1969) (quoted *supra* note 95).

<sup>137</sup> *Bosch*, 2006 WL 2548053, at \*1–2.

explanation is that the defendants hoped to exploit that time span as a statutory bar against filing civil actions more than three years after claims accrue.<sup>138</sup>

When infringement continues, dismissal without prejudice seems possible, but it is doubtful that dismissal would ever be needed. Registration, necessary for suit,<sup>139</sup> establishes an ownership claim, but—whatever the implications of § 201(b)—claims could otherwise be established. This is significant because suits contesting ownership as well as those seeking monetary relief cannot be pursued after three years.<sup>140</sup>

This probably explains why publishers, some presumably aware of § 201(b), apparently seek copyright licenses or assignments only rarely from anyone other than faculty authors.<sup>141</sup> Assuming such transactions are not concealed and constitute a reasonable basis for finding an ownership claim—at least when obligations to publish motivate bragging, not concealment—even schools should be barred from disputing ownership after three years, if not sooner.<sup>142</sup>

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<sup>138</sup> See 17 U.S.C. § 507(b) (2006).

<sup>139</sup> 17 U.S.C. § 411(a) (2006). In that respect *Forasté v. Brown University*, 248 F. Supp. 2d 71 (D. R.I. 2003) is particularly interesting. As related:

Defendants contend that Forasté lacks standing to bring a copyright infringement action because he has not registered a copyright in the images as to which he claims a copyright interest. At the time this action was filed, Plaintiff had not registered a copyright in any of the images at issue.

*Id.* at 75–76. The court concluded, however, that “it would be wholly inequitable to require that Forasté, prior to proceeding with this action, register a copyright in images to which Brown presently denies him access.” *Id.* at 78.

<sup>140</sup> See *Merchant v. Levy*, 92 F.3d 51, 56 (2d Cir. 1996); see also *Davis v. Meridian Films, Inc.*, 14 F. App’x 178, 181 (4th Cir. 2001) (applying both *Merchant* and an earlier case from the 9th Circuit); *Zuill v. Shanahan*, 80 F.3d 1366, 1369 (9th Cir. 1996) (finding § 507 applicable to claims of cotenancy, despite statutory history that might be read to the contrary).

<sup>141</sup> Shortly after *Forasté* was reported in 2003, I posted a query on Techno-L, said to be “the largest and oldest e-mail discussion forum geared exclusively towards the technology transfer industry.” Techno-L Home Page, <http://www.techno-l.org> (last visited Nov. 1, 2008). I do not recall who sent the email, but the sole respondent said that it is rare for publishers to ask for assignments from someone clearly authorized to bind the university.

<sup>142</sup> See *Weinstein v. Univ. of Ill.*, 811 F.2d 1091 (7th Cir. 1987). In that case, the court stated:

The record does not contain the contracts between the American Journal of Pharmaceutical Education and Professors Belsheim, Hutchinson, and Weinstein, but we venture a guess that each represented to the Journal that he owned the copyright and was empowered to transfer the copyright to the Journal. (The article as published carries the Journal’s copyright notice rather than that of the authors or the University of Illinois.) Dean Manasse told Weinstein to *publish* the article, not to ask the University for permission to publish—permission that would have been essential if the University owned the copyright.

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Usually, as reflected in policies such as Brown University's,<sup>143</sup> schools have no interest in owning copyright in faculty publications. Everyone might therefore be better served if faculty members had presumptive initial ownership of copyright in such work subject to limitations set forth in school policies.<sup>144</sup> As Brown University's dispute suggests,<sup>145</sup> however, those policies may be ambiguous, and ambiguities may be difficult to avoid.<sup>146</sup>

Despite lack of incentive to claim ownership in some cases,<sup>147</sup> schools as employers own copyright in faculty works.<sup>148</sup> Literal application of § 101 ("work made for hire") and § 201(b) do not depend on written policies. Moreover, literal application of those sections seems to have harmed no one over the past three decades.

It is intriguing that school ownership of copyright in employees' work has been denied only when the issue is tangential to assertions by disputants entitled to little sympathy.<sup>149</sup> Whatever the explanation for that anomaly, it is

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*Id.* at 1094–95. The proposition advanced in the last sentence is doubtful. If the Dean was unaware of § 201(b), however, his express or implied authorization should thereafter estop the university from denying it.

<sup>143</sup> See *supra* text accompanying note 109.

<sup>144</sup> This was the rule apparently adopted in *Weinstein*. See *Weinstein*, 811 F.2d at 1099.

<sup>145</sup> *Forasté v. Brown Univ.*, 248 F. Supp. 2d 71, 73–74 (D. R.I. 2003).

<sup>146</sup> See Lape, *supra* note 96, at 251–68, for analysis of "the copyright policies at seventy leading research universities in effect" a short time earlier. *Id.* at 224. As Lape stated, "many policies contain internal inconsistencies, undefined terms, and unnecessarily vague language." *Id.* at 256.

<sup>147</sup> See, e.g., Roberta Rosenthal Kwall, *Copyright Issues in Online Courses: Ownership, Authorship and Conflict*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 1 (2001). With regard to this lack of incentive, Kwall stated:

The paucity of case law involving copyright ownership of materials prepared by university faculty reflects the reality that copyrightable works created by academics have not historically generated large amounts of money. . . . Not surprisingly, universities were far more concerned with the ownership of more profitable patentable inventions. As the twenty-first century dawns, however, university interest in copyright ownership of works created by academics is intensifying, largely as a result of the potential financial windfalls associated with distance education.

*Id.* at 1–2 (footnotes omitted).

<sup>148</sup> See, e.g., Lape, *supra* note 96, at 253 ("[N]one of the policies collected in this study fails to claim at least some faculty works . . .").

<sup>149</sup> Hostility may be motivated by considerations that underlie *jus tertii*. See RESTATEMENT (SECOND) OF TORTS § 895 (1979) (defining Rights of Third Persons—*Jus Tertii*, subject to exceptions of no interest here, a party liable "for harm to or interference with land or a chattel is not relieved of the liability because a third person has a legally protected interest."). Aside

unfortunate that holdings generated in such circumstances suggest that schools have no rights absent written policies and, as a corollary, that ambiguities will be resolved against them. Such a view is at odds with the statute. Thus, courts need to consider other ways, such as enforcement of the time limit on claims,<sup>150</sup> to address only tangentially-related concerns.

### III. CONCLUSION

Customary behavior can render legal rules irrelevant.<sup>151</sup> Custom can also spark skepticism as well as guide the application and perception of rules.<sup>152</sup> *Stare decisis* aside, it is difficult to envision circumstances where legally-enforceable rules are determined by custom.<sup>153</sup>

That copyright protection for many documents has not been the subject of litigation proves nothing. At most, as in the case of legally-binding documents generated by state and local governments, it implies that exclusive rights do not exist. That is also true of privately-authored documents that have become part of a legal record, but courts might choose to regulate others' use as a function of fairness rather than to deny copyright altogether. In many situations, however, lack of reported litigation is apt to indicate only a lack of financial incentives for suit.

It seems *a priori* true that previous lack of incentives to sue should itself not bar those who find it worthwhile to assert their rights.<sup>154</sup> This proposition

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from the limitation on the types of property to which it applies, faculty members need exclusive rights to bring suit. *See supra* note 139. *Jus tertii* is therefore more analogous when a plaintiff with clear rights is also said to infringe rights of a third party. *See, e.g.,* *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973) (“Defendant also urges that copyright protection should be denied plaintiff because his works contain extracts from [the work of others]. . . . However, there is no provision . . . permitting a third person such as defendant to copy with impunity the entire composite work, thereby infringing both copyrights.”).

<sup>150</sup> *See* *Merchant v. Levy*, 92 F.3d 51, 56 (2d Cir. 1996); *see also* *Davis v. Meridian Films, Inc.*, 14 F. App'x 178, 181 (4th Cir. 2001); *Zuill v. Shanahan*, 80 F.3d 1366, 1369 (9th Cir. 1996).

<sup>151</sup> *See supra* notes 1–5 and accompanying text.

<sup>152</sup> *See, e.g.,* *United States v. J.B. Williams Co.*, 498 F.2d 414, 424–25 (2d Cir. 1974) (quoted *supra* note 7).

<sup>153</sup> *See supra* note 6.

<sup>154</sup> A noteworthy instance of that approach is provided by *Princeton University Press v. Michigan Document Services, Inc.*, 99 F.3d 1381, 1387 (6th Cir. 1996). There, the court rejected a “conten[tion] that it is circular to assume that a copyright holder is entitled to permission fees and then to measure market loss by reference to the lost fees.” *Id.* *But see* *EWP Corp. v. Reliance Univ. Inc.*, 755 F.2d 898 (Fed. Cir. 1985):

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applies to indisputably copyrightable academic works as well as to arguably copyrightable legal works. That schools have traditionally eschewed copyright in job-related work produced by employees should be seen, particularly in light of unambiguous statutory provisions, to indicate only lack of interest, not lack of right.

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When . . . the PTO issues a patent because the examiner did not consider prior art teaching the very technique essential to the claimed invention . . . it is not unusual to see astute businessmen capitalize on it by erecting a temporarily successful licensing program thereon. . . . They sometimes succeed because they are mutually beneficial to the licensed group or because of business judgments that it is cheaper to take licenses than to defend infringement suits, or for other reasons . . . . Such a “secondary consideration” must be carefully appraised as to its evidentiary value and we have tried to do that here.

*Id.* at 907–08; *see also* Rothman, *supra* note 7, at 1970 (“[W]hen customs develop to avoid litigation or to preserve relationships, they do not provide meaningful information relevant to establishing an optimal allocation of rights . . .”).